

**REMARKS**

This amendment responds to the final Office Action mailed on November 26, 2007 and further to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on May 7, 2008. Applicants respectfully submit that this response is being timely filed within one month of the mailing date of the Notice of Panel Decision from Pre-Appeal Brief Review.

Claims 1-10, 14-20 and 22-24 were pending. By the above amendments, claims 1-10 and 14-18 were canceled without prejudice or disclaimer. Accordingly, claims 19 and 22-24 remain pending the present application, and applicants believe these claims are in proper condition for allowance for the reasons set forth below.

In summary, the combination of prior art cited in the November 26, 2007 Office Action fails to teach or suggest the following features recited in independent claim 19:

- an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is automatically retrieved from an electronic address book stored at a client computer.

Claims 1, 2, 7-10, 14, 18-20 and 23 were previously rejected under 35 U.S.C. § 103(a) as being unpatentable over IBM Corporation Product Facsimile Support/400 ("IBM") in view of U.S. Patent No. 6,424,426 issued to Henry ("Henry") and U.S. Patent No. 6,775,711 issued to Akimoto ("Akimoto"). Claims 3-6, 15-17, 22 and 24 were rejected under 35 U.S.C. § 103(a) as being obvious over IBM in view of Henry and Akimoto and further in view of NetGram.com ("NetGram"). It is initially noted that claims 1-10 and 14-18 have been canceled without prejudice or disclaimer, thereby rendering their rejections moot. Applicants respectfully traverse the Examiner's rejections with respect to claims 19 and 22-24 based on the following reasons.

***Independent Claim 19 Recites Automatically Retrieving a Preferred Communication Format Indicator from an Electronic Address Book***

It is initially noted that independent claim 19 recites an electronic business transaction document containing a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving the preferred communication format indicator from an electronic address book stored at a client computer.

*IBM* is cited in the Office Action as disclosing an address book for retrieving a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, as recited in independent claim 19. Applicants respectfully traverse this characterization of *IBM* and submit that *IBM* actually teaches away from this feature.

*IBM* teaches that all communications must occur according to the industry standard CCITT Group 3 fax format, where *IBM* expressly indicates that it is an important characteristic of its Facsimile Support/400 outbound process that all pages are converted to the CCITT Group 3 fax format. *See pages 4-5 of IBM*. As such, since all communications sent to recipient parties by the *IBM* device occur according to the industry standard CCITT Group 3 fax format, it would be contradictory to the teachings of *IBM* to store different communication format indicators in the *IBM* address book.

Applicants respectfully submit that *IBM* does not disclose the limitations that the Examiner has indicated to be taught in *IBM*. Namely, there is no disclosure in *IBM* of completing an electronic business transaction documents by retrieving preferred communication formats from an electronic address book on the client computer, as recited in independent claim 19. This feature is further not taught by the other cited prior art references. *Henry* discloses a system where users manually fill out a form with email addresses and scan such form into a fax machine so that it is faxed to a fax server, where there is no teaching or suggestion in *Henry* of retrieving preferred communication formats from an electronic address book on a client computer. Still further, *Akimoto* discloses an email communication system where all communications are sent according to an email transfer protocol format and there is again no teaching or suggestion of retrieving preferred communication formats from an electronic address book on a client computer. The Examiner has further recognized the

shortcomings of *IBM* in failing to disclose such a feature when stating: “*IBM does not explicitly teach preferred format indicator for each of the plurality of recipient parties of the business transaction.*” See page 4, lines 11-12 of November 26, 2007 Office Action.

Thus, it is respectfully submitted that the combination of *IBM*, *Henry* and *Akimoto* fails to teach or suggest creating an electronic business transaction document a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving preferred communication format indicators from an electronic address book stored at a client computer. Thus, applicants submit that all of the limitations of independent claim 19 are not taught or suggested by the combination of cited prior art, and it is respectfully submitted that independent claim 19 and its respective dependent claims are patentable over the cited prior art of record. Early allowance of these claims is hereby requested.

Dependent claim 22 further recites automatically associating a recipient party with their preferred communication format indicator when a recipient party is added to the electronic business transaction document. As set forth herein, the combination of cited prior art fails to associate recipient parties with respective preferred communication format indicator and it necessarily follows that the combination of cited prior art must also fail to teach or suggest automatically associating a recipient party a preferred communication format indicator when a recipient party is added to an electronic business transaction document. Applicants respectfully submit that dependent claim 22 is separately patentable over the cited prior art of record.

***Independent Claim 19 Further Requires Transmission of an Electronic Business Document Between a Computer and Server Over a Computer Network***

Independent claim 19 of the present application recites that the electronic business transaction document is created on a client computer and is received by the transaction service server computer communicating with the client computer through a computer network. *Henry* is cited in the Office Action as teaching a business server capable of sending business documents in different formats. However, *Henry* does not teach a business management software program as disclosed in the present application nor does *Henry* disclose a server receiving an electronic business document over a computer network. Rather, *Henry* discloses technology related to the Internet fax service MongoNet (e.g., see [www.mongonet.com](http://www.mongonet.com)) where users manually fill out a form with email addresses

and scan such form into a fax machine so that it is faxed to a fax server. The document in *Henry* is created by a user that fills in the email address on the form, not by a computer program. The document in *Henry* is sent via facsimile to the fax server, not over a computer network in electronic form to the server. Thus, it is respectfully submitted that *Henry* fails to teach a transaction server computer that receives an electronic business transaction document created on a client computer that is received through a computer network, as recited in independent claim 19.

***The Cited Prior Art Fails to Teach or Suggest a Server Computer Interpreting a Preferred Communication Format of the Recipient Parties Indicated in the Business Transaction Document***

Independent claim 19 further recites that the electronic business transaction document includes a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is to be sent to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format. The transaction service server computer receives the electronic business transaction document over a computer network, interprets the preferred communication format indicators of each of the plurality of recipient parties of the business transaction, and sends the electronic business transaction document to the recipient parties in their interpreted preferred communication format.

It is admitted in the Office Action that “IBM in view of *Henry* does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction.” *See first full paragraph on page 5 of the Office Action.* Both the January 29, 2008 Advisory Action and the November 26, 2007 Office Action cite *Akimoto* to cure the deficiency of determining a preferred communication format for each of the plurality of recipient parties of the business transaction, where *Akimoto* is cited as teaching this feature.

However, *Akimoto* fails to teach or suggest determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction and then sending the business transaction document in the preferred

communication format of a recipient party (where at least one recipient party receives the document in a computer communication format and at least one other recipient party receives it in a non-computer communication format). To the contrary, *Akimoto* is directed to an email communication system having a single communication format – namely, all communications occur according to a standard MIME email format. See col. 5, lines 19-54 & col. 9, lines 44-47 of *Akimoto*. There is no teaching or suggestion in *Akimoto* that transmissions to recipients can occur in any format other than standard email transfer protocol format (i.e., MIME).

The Office Action cites *Akimoto*'s Figure 8 and the associated description as teaching a determination of preferred communication formats of recipient parties. See Page 5, Final Office Action dated November 26, 2007 and Continuation Sheet (PTO-303) attached to the Advisory Action dated January 29, 2008. Rather than describing preferred communication formats (i.e., computer communication format or non-computer communication format) of recipient parties, Figure 8 and its related description in *Akimoto* discuss how various identification characters can be used to signify that certain processes be performed on the email that is being sent. The email communication system of *Akimoto* detects special characters "A" to "C" after the identification character "@" in the email address to determine that special processing associated with these characters is executed. See *Akimoto*, col. 8, lines 30-35 (describing Figure 8). Figure 7 brings further understanding to *Akimoto*'s identification characters. Here, as identification characters, characters "A" to "C" are used in addition to "@" in order to determine processing respectively associated with these identification characters. When the identification "A" is added, signature processing is carried out. When the identification "B" is added, encryption processing is carried out. When the identification "C" is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file." See *Akimoto*, col. 7, lines 25-35 (describing Figure 7).

However, as clearly shown at the bottom of the flow chart illustrated in Figure 8, regardless of which type of content processing has been indicated to be performed, all communications are ultimately transmitted in (step T15) in an email transmission protocol format where determinations are made in steps (T13) and (T14) to ensure that the recipient

address is a suitable email format. *See Akimoto, col. 8, lines 60-65.* Instead of disclosing determining different communication formats as asserted in the Office Action, Figure 8 and the respective description of Figure 8 in *Akimoto* discuss how various identification characters are used to process the content of an email (e.g., signature or encryption processing) before the content is transmitted according to an email transfer protocol format, irregardless of the type of the content processing that was performed according to the identification characters. For example, see column 9, lines 44-47 of *Akimoto* which recites that the server only performs processing of the content (i.e., image data) according to the identification characters, but thereafter sends the processed image data in accordance with an e-mail transfer protocol. As such, *Akimoto* only discloses that a computer communication format (i.e., email transfer protocol) is used for all recipient parties.

It is respectfully submitted that the communication format remains unchanged in *Akimoto* (e.g., the communication format is always e-mail transfer protocol). As such, *Akimoto* fails to cure the deficiency of *IBM* and *Henry* admitted by the Examiner as failing to teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. In fact, just as *Akimoto* discloses that all communications occur according to an email communication format, *IBM* also teaches that a single communication format be used for all communications, namely *IBM* teaches that industry standard CCITT Group 3 fax format be used. *See pages 4-5 of IBM.* As described in paragraph [0003] of the present specification, the use of such industry-wide standards for all communications is a limitation on business that the electronic transaction service system of the present application is designed to avoid.

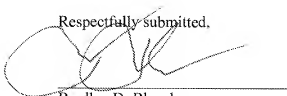
To the contrary of the cited prior art, independent claim 19 recites that transaction service server computer determines a preferred communication format for each of the plurality of recipient parties of the business transaction by interpreting communication format indicators in the electronic business transaction document itself. Independent claim 19 further recites that it is determined whether the preferred format is either a computer communication format or a non-computer communication format, where the business transaction document is sent to the

recipient in the preferred communication format. As such, the combination of *IBM, Henry* and *Akimoto* fails to teach or suggest all of the limitations of independent claim 19. It is respectfully submitted that the obviousness rejection of independent claim 19 and its respective dependent claims cannot be maintained in view of the combination of *IBM, Henry* and *Akimoto*, and applicants submit that such claims are now in proper condition for allowance.

### CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned at 949-732-6539, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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